



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,690	12/04/2001	Richard Wojdyla	5384/55373	9872
7590	05/06/2005		EXAMINER	
KEITH E. GEORGE, ESQ. McDERMOTT, WILL & EMERY 600 13th STREET N.W. WASHINGTON, DC 20005-3096			LE, UYEN CHAU N	
			ART UNIT	PAPER NUMBER
			2876	
DATE MAILED: 05/06/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary	Application No.	Applicant(s)	
	10/007,690	WOJDYLA ET AL	
	Examiner	Art Unit	
	Uyen-Chau N. Le	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 31 January 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4,8-18 and 21-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 12-18,21-25 and 27-32 is/are allowed.
- 6) Claim(s) 1,3,4,9 and 10 is/are rejected.
- 7) Claim(s) 2,8,11 and 26 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

<ol style="list-style-type: none"> 1)<input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3)<input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. 	<ol style="list-style-type: none"> 4)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____. 5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6)<input type="checkbox"/> Other: _____.
--	--

DETAILED ACTION

Prelim. Amdt/Amendment

1. Receipt is acknowledged of the Amendment filed 31 January 2005.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 3, 4 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cordery et al (US 6,073,125) in view of Pickering Jr. et al (US 6,557,755).

Re claims 1, 3, 4 and 9-10: Cordery et al discloses a method for controlled mail acceptance an evidencing comprising creating a plurality of mail pieces 104 having a first identification code (i.e., an encrypted indicia) printed thereon (col. 2, lines 5+); creating a mailing statement 106 for the

(i.e., an encrypted indicia) printed thereon (col. 2, lines 5+); creating a mailing statement 106 for the plurality of mail pieces 104 (fig. 1; col. 3, lines 50+) containing a second identification code (i.e., K_m) (col. 2, lines 8+); and submitting the plurality of mail pieces to a postal service facility (col. 4, lines 52+); wherein the step providing first identification/tracing code on each of the plurality of mail pieces 104 includes the step of passing each of the plurality of mail pieces through identification/tracing code producing equipment (fig. 2; col. 2, lines 40+); wherein the first identification/tracing code is independent from a meter imprint (i.e., the first identification/tracing code is encrypted).

Cordery et al is silent with respect to the first and second identification codes correspond to a source of the mail pieces and utilize as tracing codes.

Pickering Jr. et al teaches PLANET code 202 (or a first code) is used to encode any suitable information including customer ID or mailing and subscriber ID (i.e., a sender or source of the mail pieces) (col. 3, lines 43+); a translation file or mail statement contains/stores PLANET code 202 (or a second code) associated with a mail piece (col. 8, lines 10+); PLANET code 202 being read by a plurality of readers 314 located at various locations in the mail stream (i.e., from the origin to the destination) to track the mail pieces location, and a current status of each mail piece is updated every time the PLANET code 202 is read (fig. 3; col. 10, lines 5-32). Although Pickering Jr. et al discloses that the mail-piece records used to track payment of invoices, an origin or source of the mail-piece can also be traced base on the routine of the mail-piece in the records.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the PLANET code (i.e., a code contains the source information and serves as a tracing code) of Pickering Jr. et al into the system as taught by Cordery et al in order to provide

Cordery et al with a capability of tracing the mail back to its origin/source, thus providing a more secure system in the event of mails violation (i.e., anthrax, etc.), and therefore an obvious expedient.

Allowable Subject Matter

5. Claims 2, 8, 11 and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of records to Cordery et al, Pickering Jr. et al, Pintsov and all other cited references, taken alone or in combination, fails to teach or fairly suggest the specific structure or the method for providing traceability of mail pieces comprising, among other things, scanning the mailing statement to read the second tracing code; scanning at least a sampling of the plurality of mail pieces to read the first tracing code; and verifying that the first the tracing code corresponds to the second tracing code; capturing and recording an identity of an individual submitting the plurality mail pieces as set forth in the claims combination.

7. Claims 12-18, 21-25 and 27-32 are allowed.

8. The following is an examiner's statement of reasons for allowance:

The prior art of records to Cordery et al, Pickering Jr. et al, Pintsov and all other cited references, taken alone or in combination, fails to teach or fairly suggest the specific structure or the method for providing traceability of mail pieces comprising, among other things, verifying that the encrypted source tracing code corresponds to a source of the mail pieces; capturing and storing the identity of an individual submitting the at least one mail piece; storing information produced by the source tracing code producing equipment in association with the captured and stored identity of the

individual submitting the at least one mail piece; recording the identity of the mailer in association with the encrypted tracing code; and reading the encrypted tracing code on the at least one envelope to verify the source of the envelope as set forth in the claims combination.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

9. Applicant's arguments filed 31 January 2005 have been fully considered but they are not persuasive.

10. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

11. In response to the Applicant's argument to "... the proposed combination does not teach, disclose or suggest a method for providing traceability of mail pieces, or providing a tracing code on each of the plurality mail pieces and on a mailing statement corresponding to a source of the mail pieces..." (p. 11, lines 3-7), the examiner respectfully requests the Applicant to further review the primary reference to Cordery et al in which a first encrypted code is printed on the plurality of mail pieces 104, and a second code is contained in a mailing statement 106. Cordery et al is silent with respect to the first and second correspond to a source of the mail pieces and are tracing codes. The secondary reference to Perkering Jr. et al teaches a PLANET code 202 is encoded with a sender

ID (i.e., source) and is used as a tracing code for tracking current location of the mail piece. Accordingly, the claimed limitation, given the broadest reasonable interpretation, Cordery et al in view of Perkering Jr. et al meets the claimed invention (see the rejection above).

For the reasons stated above, the Examiner believes that a proper *prima-facie* case of obviousness has been established. Therefore, the Examiner has made this Office Action final.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents to Kovalkas (US 20030089765 A1) and Masuko (JP 2002355613 A) are cited as of interest and illustrate a similar structure to a method and system for mailing security and traceability.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 571-272-2397. The examiner can normally be reached on Mon, Wed. and Fri. 5:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Uyen-Chau N. Le
May 2, 2005


THIEN M. LE
PRIMARY EXAMINER